

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Patrick A. Aliffi, et al.
Patent No.: 7,536,346
Serial No.: 10/021,468
Issued: May 19, 2009
Filing Date: October 29, 2001
For: SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS FINANCIAL
INFORMATION EXCHANGES

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT DETERMINATION

Sir:

1. Applicants filed a Communication Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance (hereinafter "First Communication") on January 30, 2009, a copy of which is attached hereto as Attachment A. In the First Communication, Applicants asserted that the PTA of 795 days that was set forth in the Notice of Allowance, mailed October 30, 2008, was erroneous. Applicants stated the belief that the correct total PTA due was 1633 days.

2. In response to the First Communication, the United States Patent and Trademark Office issued, on April 16, 2009, a decision **held in abeyance** until after the actual patent date (hereinafter "USPTO Response"). A copy of the USPTO Response is attached hereto as Attachment B in accordance with page 2 of the USPTO Response.

3. The actual patent issued May 19, 2009. The face of the patent sets forth a PTA of 795 days, the same amount of PTA set forth in the Notice of Allowance. It is believed that this total is still erroneous and that the correct total PTA is 1633 days.

4. Accordingly, Applicants submit this Renewed Request for Reconsideration of Patent Term Adjustment Determination under 37 C.F.R. § 1.705(d) and pursuant to page 2 of the USPTO response, requesting that the United States Patent & Trademark Office reconsider and correct the PTA due.

5. The determination of the total PTA of 795 days is erroneous because the United States Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the PTA History (*See* Exhibit A of Attachment A) is correct, however, it only accounts for one of the delays of the PTO. The other delay warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (*i.e.*, 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the PTA History (*See* Exhibit A of Attachment A) is correct. Thus, the correct total PTA to date is 1633 days (*i.e.*, 1673 days – 40 days).

6. Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

7. In accordance with 1.705(d), this application for patent term adjustment is filed within two (2) months from the issue date of the patent.

8. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

i) The correct total PTA credit is 1673 days.

ii) The basis for the 876 days PTA credit is under § 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 797 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

9. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of December 30, 2002, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a). Thus, this period of delay runs from December 30, 2002 to May 23, 2005. This period of delay is 876 days.

Thus, the total period of delay for this part of the PTA credit is 876.

ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of October 30, 2004, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and the date of January 4, 2007, which is the date that a request for continued examination of the application under 35 U.S.C. § 132(b) was filed. Thus, the period of delay runs from October 30, 2004 to January 4, 2007 on which the request for continued examination was filed.

Thus, the total period of delay for this part of the PTA credit is 797 days.

iii) The total PTA under § 1.703(f) is 1633 days, which is the total PTA credits for PTO delay of 876 days plus 797 days less the total PTA debits for applicant delay of 40 days.

10. The patent is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

11. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

i) The Information Disclosure Statement filed September 2, 2005 was filed after the initial response and is considered a supplemental reply. Under

RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

§ 1.704(b)(8), the period of adjustment for delay associated with this reply begins on the day of filing of the Response on August 23, 2005 and ends on the date the Information Disclosure Statement was filed. Thus, the period of delay runs from August 23, 2005 to September 2, 2005. This period of delay is 10 days.

ii) The Request for Continued Examination filed January 4, 2007 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 5, 2006 and ends on the date the reply was filed. Thus, the period of delay runs from December 6, 2006 to January 4, 2007. This period of delay is 30 days.

Thus, the total period of delay for applicant delay is 40 days (10 days + 30).

12. No fees are believed due for this renewed request based on the payment of the fees under 37 C.F.R. § 1.18(e) with the submission of the First Communication, and the United States Patent and Trademark Office's statement in the USPTO Response that no further fees are required. See USPTO Response, pages 2-3.

13. Applicants respectfully request the PTA determined by the United States Patent and Trademark Office be reconsidered and corrected.

Respectfully submitted,

Date: June 25, 2009

/Jason D. Gardner 58180/

Jason D. Gardner
Reg. No. 58180

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ATTACHMENT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Patrick A. Aliffi *et al.*
Ser. No. : 10/021,468
Filing Date : October 29, 2001
For : SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS
FINANCIAL INFORMATION
Examiner : Mamon A. Obeid
Art Unit : 3621
Atty. Docket : E0019/258247

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Communication Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on October 30, 2008 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that indicated that the total PTA to date is 795 days. It is believed that this total is erroneous and that the correct total PTA to date is 1633 days.

2. The determination of the total PTA of 795 days is erroneous because the US Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct, however, it only accounts for one of the delays of the PTO. The other delay

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this submission is being filed via EFS
Web with the U.S. Patent and Trademark Office on January 30, 2009.

/s/ Angela M. Rossi/
Angela M. Rossi

warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (*i.e.*, 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1633 days (*i.e.*, 1673 days – 40 days).

Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

3. In accordance with 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

4. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

- i) The correct total PTA credit is 1673 days.
- ii) The basis for the 876 days PTA credit is under §§ 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 797 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

5. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

- i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of December 30, 2002, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a). Thus, this period of delay runs from December 30, 2002 to May 23, 2005. This period of delay is 876 days.

Thus, the total period of delay for this part of the PTA credit is 876.

- ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of October 30, 2004, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and the date of January 4, 2007, which is the date that a request for continued examination of the application under 35 U.S.C. § 132(b) was filed. Thus, the period of delay runs from October 30, 2004 to January 4, 2007 on which the request for continued examination was filed.

Thus, the total period of delay for this part of the PTA credit is 797 days.

- iii) The total PTA under § 1.703(f) is 1633 days, which is the total PTA credits for PTO delay of 876 days plus 797 days less the total PTA debits for applicant delay of 40 days.

6. Any patent granted on this application is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

7. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

- i) The Information Disclosure Statement filed September 2, 2005 was filed after the initial response and is considered a supplemental reply. Under § 1.704(b)(8), the period of adjustment for delay associated with this reply begins on the day of filing of the Response on August 23, 2005 and ends on the date the Information Disclosure Statement was filed. Thus, the period of delay runs from August 23, 2005 to September 2, 2005. This period of delay is 10 days.
- ii) The Request for Continued Examination filed January 4, 2007 was filed after the three month period for filing a response.

Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 5, 2006 and ends on the date the reply was filed.

Thus, the period of delay runs from December 6, 2006 to January 4, 2007. This period of delay is 30 days.

Thus, the total period of delay for applicant delay is 40 days (10 days + 30).

The Commissioner is authorized to charge the firm's credit card in the amount of \$200.00 pursuant to 37 CFR 1.18(e). The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855. If there any issues concerning this Communication that can be resolved via a telephone communication, the Office is invited to contact the undersigned.

Respectfully submitted,

/Jason D. Gardner 58180/
Jason D. Gardner
Reg. No. 58180
Attorney for Assignee

KILPATRICK STOCKTON LLP
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Atlanta, Georgia 30309
Telephone: 404-815-6500
Facsimile: 404-815-6555
Attorney Docket No. 41577/295089

Encl.: Exhibit A - Copy of PTA History for Application No. 10/021,468 printed from PAIR on January 21, 2009

EXHIBIT A.

| | | |
|------------|---|----------------------|
| 10/021,468 | SYSTEM AND METHOD FOR FACILITATING RECIPROCATIVE SMALL BUSINESS FINANCIAL INFORMATION EXCHANGES | 01-21-2009::09:10:48 |
|------------|---|----------------------|

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/021,468

| | | | |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date: | 10-29-2001 | USPTO Delay (PTO) Delay (days): | 893 |
| Issue Date of Patent: | - | Three Years: | - |
| Pre-Issue Petitions (days): | +0 | Applicant Delay (APPL) Delay (days): | 98 |
| Post-Issue Petitions (days): | +0 | Total PTA (days): | 795 |
| USPTO Adjustment(days): | +0 | Explanation Of Calculations | |

Patent Term Adjustment History

| Date | Contents Description | PTO(Days) | APPL(Days) |
|------------|---|-----------|------------|
| 10-30-2008 | Mail Notice of Allowance | | |
| 10-27-2008 | Document Verification | | |
| 10-27-2008 | Examiner's Amendment Communication | | |
| 10-27-2008 | Notice of Allowance Data Verification Completed | | |
| 08-21-2008 | Date Forwarded to Examiner | | |
| 08-21-2008 | Date Forwarded to Examiner | | |
| 08-15-2008 | Request for Continued Examination (RCE) | | 58 |
| 08-21-2008 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA) | | ↑ |
| 08-15-2008 | Request for Extension of Time - Granted | | ↑ |
| 08-15-2008 | Workflow - Request for RCE - Begin | | ↑ |
| 03-06-2008 | Miscellaneous Incoming Letter | | ↑ |
| 02-29-2008 | Miscellaneous Incoming Letter | | ↑ |
| 03-18-2008 | Mail Final Rejection (PTOL - 326) | 17 | |
| 03-14-2008 | Final Rejection | ↑ | |
| 03-05-2008 | Case Docketed to Examiner in GAU | ↑ | |
| 03-05-2008 | Mail Appeals conf. Proceed to BPAI | ↑ | |
| 02-28-2008 | Pre-Appeals Conference Decision - Proceed to BPAI | ↑ | |
| 02-19-2008 | Case Docketed to Examiner In GAU | ↑ | |
| 12-26-2007 | Request for Pre-Appeal Conference Filed | ↑ | |
| 12-29-2007 | Date Forwarded to Examiner | ↑ | |
| 12-26-2007 | Amendment/Argument after Notice of Appeal | ↑ | |
| 11-26-2007 | Notice of Appeal Filed | ↑ | |
| 11-26-2007 | Mail Advisory Action (PTOL - 303) | ↑ | |
| 11-24-2007 | Advisory Action (PTOL-303) | ↑ | |
| 11-05-2007 | Date Forwarded to Examiner | ↑ | |
| 11-01-2007 | Amendment after Final Rejection | ↑ | |
| 09-24-2007 | Mail Final Rejection (PTOL - 326) | | |
| 09-12-2007 | Final Rejection | | |
| 07-10-2007 | Date Forwarded to Examiner | | |
| 07-03-2007 | Response after Non-Final Action | | |

| | | |
|------------|--|-----|
| 04-04-2007 | Mail Non-Final Rejection | |
| 03-26-2007 | Non-Final Rejection | |
| 11-06-2006 | Information Disclosure Statement considered | |
| 01-09-2007 | Miscellaneous Incoming Letter | |
| 01-13-2007 | Date Forwarded to Examiner | |
| 01-13-2007 | Date Forwarded to Examiner | |
| 01-04-2007 | Request for Continued Examination (RCE) | 30 |
| 01-13-2007 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA) | ↑ |
| 01-04-2007 | Request for Extension of Time - Granted | ↑ |
| 01-04-2007 | Workflow - Request for RCE - Begin | ↑ |
| 12-11-2006 | Mail Advisory Action (PTOL - 303) | ↑ |
| 12-04-2006 | Advisory Action (PTOL-303) | ↑ |
| 11-06-2006 | Reference capture on IDS | ↑ |
| 11-06-2006 | Information Disclosure Statement (IDS) Filed | ↑ |
| 11-06-2006 | Information Disclosure Statement (IDS) Filed | ↑ |
| 11-16-2006 | Date Forwarded to Examiner | ↑ |
| 11-06-2006 | Amendment after Final Rejection | ↑ |
| 11-06-2006 | Request for Foreign Priority (Priority Papers May Be Included) | ↑ |
| 09-05-2006 | Mail Final Rejection (PTOL - 326) | ↑ |
| 08-28-2006 | Final Rejection | |
| 06-23-2006 | Date Forwarded to Examiner | |
| 06-20-2006 | Response after Non-Final Action | |
| 04-28-2006 | Case Docketed to Examiner in GAU | |
| 03-20-2006 | Mail Non-Final Rejection | |
| 03-10-2006 | Non-Final Rejection | |
| 09-02-2005 | Information Disclosure Statement considered | |
| 02-14-2005 | Information Disclosure Statement considered | |
| 01-13-2006 | Date Forwarded to Examiner | |
| 01-10-2006 | Response to Election / Restriction Filed | |
| 01-10-2006 | Request for Extension of Time - Granted | |
| 11-04-2005 | Mail Restriction Requirement | |
| 11-02-2005 | Requirement for Restriction / Election | |
| 09-02-2005 | Reference capture on IDS | |
| 09-02-2005 | Information Disclosure Statement (IDS) Filed | 10 |
| 09-02-2005 | Information Disclosure Statement (IDS) Filed | |
| 09-01-2005 | Date Forwarded to Examiner | ↑ |
| 08-23-2005 | Response after Non-Final Action | ↑ |
| 05-23-2005 | Mail Non-Final Rejection | 876 |
| 05-19-2005 | Non-Final Rejection | ↑ |
| 05-13-2005 | Case Docketed to Examiner in GAU | ↑ |

| | | |
|------------|--|---|
| 02-14-2005 | Reference capture on IDS | ↑ |
| 02-14-2005 | Information Disclosure Statement (IDS) Filed | ↑ |
| 02-14-2005 | Information Disclosure Statement (IDS) Filed | ↑ |
| 05-10-2004 | IFW TSS Processing by Tech Center Complete | ↑ |
| 05-29-2002 | Case Docketed to Examiner in GAU | ↑ |
| 04-23-2002 | Case Docketed to Examiner in GAU | ↑ |
| 03-29-2002 | Application Dispatched from OIPE | ↑ |
| 03-20-2002 | Application Is Now Complete | ↑ |
| 02-12-2002 | Additional Application Filing Fees | ↑ |
| 02-12-2002 | Small Entity Statement (37 CFR 1.27) | ↑ |
| 02-12-2002 | Applicant has submitted new drawings to correct Corrected Papers problems | ↑ |
| 01-15-2002 | Corrected Paper | ↑ |
| 12-31-2001 | IFW Scan & PACR Auto Security Review | ↑ |
| 10-29-2001 | Initial Exam Team nn | ↑ |

Close Window

ATTACHMENT B



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

MAILED

APR 16 2009

OFFICE OF PETITIONS

In re Application of :
ALIFFI et al. :
Application No. 10/021,468 : ON APPLICATION FOR
Filed: October 29, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. E0019/258247 :

This is in response to the Communication Regarding Patent Term Adjustment (PTA) indicated in Notice of Allowance filed January 30, 2009. Applicant requests that the determination of patent term adjustment be corrected from 795 days to 1633 days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness

of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on January 4, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney, Christina Tartera Donnell, at (571) 272-3211.



Kery A. Fries
Senior Legal Advisor
Office Patent Legal Administration